

REMARKS

This paper is being filed concurrently with a Request for Continued Examination.
Claims 13-19 are pending in this application.

As to the Merits:

As to the merits of this case, the Examiner maintains the following rejections:

claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Li; and

claims 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Li in
view of Dorenbosch et al. (of record).

Each of these rejections is respectfully traversed.

In the response filed on June 10, 2008, it was submitted that the Examiner has failed to appreciate that claim 13 requires that the instant message received from the terminal of the forwarder is stored in the communication device when the user of the forwarding destination is not logged in the instant message server.

In other words, while Li may disclose that a request message to the new buddy user can be stored by server device 106 and provided to the buddy user when he/she comes online again, in claim 13 the instant message is not stored in the instant message server, but instead is stored in the communication device.

For example, as shown in Fig. 1 of the present application, the first client terminal 16A and the second client terminal 16B are client terminals that log into the IM server 14 to use the IM service. The communication device 100 also includes a function as a client terminal of the IM server 14. In addition, the communication device 100 includes a function for temporarily storing the instant message, and when a transmission destination logs in, transmitting the instant message.

Independent claim 13 includes a terminal of a forwarder, i.e., first client terminal 16A, a terminal of a forwarding destination, i.e., second client terminal 16B, an instant message server, i.e., IM server 14, and a communication device, i.e., communication device server 100, which are all shown, for example, in Figure 1 of the present application.

That is, while Li clearly discloses that an optional dedicated server device 106 may be connected in the peer to peer network, as shown in Figure 2A, it is respectfully submitted that such server device 106 fails to constitute an instant message server, and instead corresponds to the communication device server 100 and not the IM server 14, for example, as shown in Figure

1 of the present application. That is, as noted by the Examiner, Li discloses that “a request message to the new buddy user can be stored by server device 106 and provided to the buddy user when he/she comes online again,” which is the same function performed by the communication device in claim 13.

For example, claim 13 calls for *transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device when the user of the forwarding destination is not logged in the instant message serve, ...*

detecting by the communication device, whether or not the user of the forwarding destination designated as the terminal of the forwarding destination is logged in the instant message server; and

transmitting the instant message stored in the means for storing from the communication device to the terminal of the forwarding destination when the user of the forwarding destination logs into the instant message server.

Accordingly, it is respectfully submitted that Li, at best, suggests that the server device 106 may perform a similar feature as the communication device in claim 13, Li simply fails to include an IM server in its peer to peer network. As such, it is respectfully submitted that Li fails to disclose the following features set forth in claim 13:

*detecting by a terminal of a forwarder, whether or not a user of a terminal of a forwarding destination is logged in **an instant message server**;*

*transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device when the user of the forwarding destination is not logged in **the instant message server**; ...*

*detecting by the communication device, whether or not the user of the forwarding destination designated as the terminal of the forwarding destination is logged in **the instant message server**; and*

*transmitting the instant message stored in the means for storing from the communication device to the terminal of the forwarding destination **when the user of the forwarding destination logs into the instant message server**,*

In the advisory action dated July 2, 2008, the Examiner takes the position in item 2, page 2 of the Action, that claim 13 does not specify that a communication device is any different than the instant message server, and that the Examiner can assume that the communication device is merely an application running on the instant message server.

However, it is submitted that the Examiner's claim construction regarding the communication device of claim 13 being considered as a mere application running on the server 106 of Li is inconsistent with the explicitly language of claim 13 as well as the disclosure of the present application. That is, while the Examiner is entitled to the broadest reasonable claim

interpretation during prosecution before the U.S. Patent Office, such interpretation must be consistent with the subject matter disclosed in the application. In other words, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

Claim 13 recites, "storing the instant message received from the terminal of the forwarder in means for storing of the communication device." For example, as shown in Fig. 2 of the present application the communication device 100 includes a storage processing unit 104 and a transmission content storage unit 106, which stores the instant message received from the first client terminal 16a when the second client terminal 16b is not logged into the IM server 14.

In contrast, a mere application running of the server 106 in Li does not constitute a device and does not include any type of means for storing instant messages, as required by claim 13.

Therefore, the Examiner's position that the communication device can be considered to be a mere application running on the server 106 is inconsistent with the features of claim 13 and the subject matter of the present application, since the communication device 100 is clearly shown to be a separate device form the IM server 14 in the present application.

In addition, independent claim 13, as attached herewith, has been amended in order to specify that the instant message is transmitted from the terminal of the forwarder to a communication device, and not the instant message server, when the user of the forwarding destination is not logged in the instant message server. That is, it is submitted that such amendments clearly distinguish claim 13 from the disclosure of Li, since Li discloses that a request message to the new buddy user can be stored by the server device 106 and provided to the buddy user when he/she comes on line, whereas in claim 13, the instant message is not stored in the instant message server, but instead is stored in the communication device.

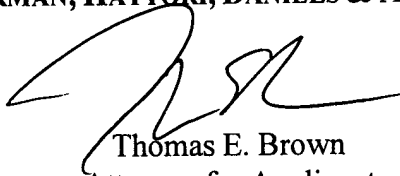
If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

Application No. 10/809,889
Attorney Docket No. 042089

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'TEB', is written over the printed name of Thomas E. Brown.

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